

Amendment and Response

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Serial No.: 09/845,946

Confirmation No.: 3318

Filed: 30 April 2001

For: A COATED FILM LAMINATE HAVING AN IONIC SURFACE

Remarks

The Office Action mailed 19 June 2003 has been received and reviewed. Claims 1, 10, 13-15, 21-23, 25, 28, and 32 having been amended, and claims 35-38 having been added, the pending claims are claims 1-38. Claims 10-22 have been withdrawn from consideration by the Examiner.

Independent claims 1, 10, 15, 23, 28, and 32 have been amended to recite "a substrate comprising a relaxed oriented film or a relaxed elastomeric material," which is supported by the specification at, for example, page 14, lines 3-5. Independent claims 1, 10, 15, 23, 28, and 32 have also been amended to move the recitation that "the laminate has a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area" from the preamble into the body of the claim.

Claim 25 has been rewritten in independent form.

New claim 35, which does not recite "4-vinylbenzyltrimethylammonium chloride" in the Markush group, is supported, for example, by claim 1. New claim 36 is supported, for example, by the specification at page 6, line 22, and page 7, lines 5-26, and Figures 1b, 2b, and 3b. New claims 37-38 are supported by the specification at, for example, page 7, lines 1-4.

Reconsideration and withdrawal of the rejections are respectfully requested.

Obviousness-Type Double Patenting Rejection

Claims 32-34 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent Application No. 09/860,944. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response. In the event that the provisional obviousness-type double patenting rejection is the only rejection remaining in the present application, Applicants respectfully request that the Examiner withdraw the provisional rejection and allow the application to issue as a patent pursuant to M.P.E.P. §804(I)(B).

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Rejection under 35 U.S.C. §102

The Examiner rejected claims 1-9 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,329,113 (Bourdelaïs et al.). Applicants respectfully traverse the rejection.

Independent claim 1 (as amended) recites, in the body of the claim, that the laminate has a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area.

In contrast, Bourdelaïs et al. disclose "an imaging member comprising a base wherein said base comprises at least one layer of heat shrinkable sheet and at least one strength layer" (Abstract). "By providing a heat shrinkable sheet in combination with a strength layer, the magnitude and direction of the curl of the imaging base can be altered before or after the imaging layers have been applied to the base of the invention" (column 3, lines 63-67). "The strength layer in the present invention allows the base to retain the form after the heat shrink layer has changed dimension" (column 4, lines 48-50).

Although Bourdelaïs et al. disclose an imaging member that includes a heat shrinkable sheet, Applicants respectfully submit that Bourdelaïs et al. fail to specifically disclose or suggest a laminate having a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area. In fact, Bourdelaïs et al. require that the imaging member include a strength layer to allow "the base to retain the form after the heat shrink layer has changed dimension" (column 4, lines 48-50). Thus, Applicants respectfully submit that claim 1 is patentable over Bourdelaïs et al.

Further, in preferred embodiments of the present invention, the laminate has an undulated surface (e.g., new claim 36); the topographical surface area is at least about five times greater than the projected surface area (e.g., new claim 37); or the topographical surface area is at least fifteen times greater than the projected surface area (e.g., new claim 38). Applicants respectfully submit that new claims 36-38 are also patentable over Bourdelaïs et al.

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The Examiner rejected claims 1-9, 23-24, and 26-34 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,403,278 (Fehervari et al.) with additional evidence provided by U.S. Pat. No. 5,593,809 (Kim et al.), which was incorporated by reference.

Applicants respectfully traverse the rejection.

Independent claims 1, 23, 28, and 32 (as amended) each recite a substrate comprising a relaxed oriented film or a relaxed elastomeric material. Applicants respectfully submit that Fehervari et al. with additional evidence provided by Kim et al. fail to disclose or suggest a laminate that includes a substrate comprising a relaxed oriented film or a relaxed elastomeric material (e.g., claims 1-9, 23-24, and 26-34).

For at least the reasons presented herein above, Applicants respectfully submit that the presently pending claims are patentable over the cited art. In view of the amendments and remarks presented herein, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102.

Request for Rejoinder

Claims 10-22 have been withdrawn from consideration as being drawn to non-elected subject matter as a result of the Restriction Requirement mailed 1 October 2002. The non-elected claims have been amended in accordance with the currently pending claims. In view of the common language recited in the pending and withdrawn claims, Applicants respectfully request that the Examiner reconsider the Restriction Requirement, and rejoin and examine the withdrawn claims with the claims currently under examination.

New Claims

New claim 35, which is supported by claim 1, does not recite "4-vinylbenzyltrimethylammonium chloride" in the Markush group. Applicants respectfully submit

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that new claim 35 is patentable for at least the reasons recited herein above for the patentability of claim 1.

Applicants respectfully submit that new claims 36-38, which depend from claim 1 and have been discussed herein above in the remarks to the Rejections under 35 U.S.C. §102, are also patentable over the cited art.

Applicants respectfully request that the new claims be entered, considered, and passed on to allowance.

Allowable Subject Matter

Applicants thank the Examiner for noting that claim 25 would be allowable if rewritten in independent form. Claim 25 having been rewritten in independent form, Applicants respectfully request that claim 25 be passed on to allowance.

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of September, 2003, at 2:23 p.m. (Central Time).

By: Name: Rachel Gagliardi-Gebhardt